No. 12862

IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT

HARWOOD A. WHITE,

Appellant,

vs.

SUSAN C. KIMMELL and E. P. DUTTON AND COMPANY, INC., a corporation,

Appellees.

APPELLEES' BRIEF.

LESLIE F. KIMMELL,
215-D Ocean Avenue,
Laguna Beach, California,
Attorney for Appellees.

Parker & Company, Law Printers, Los Angeles. Phone MA. 6-9171.

TOPICAL INDEX.

TABLE OF AUTHORITIES CITED.

Cases.

Statutes

Textbooks

No. 12862

IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT

HARWOOD A. WHITE,

Appellant,

vs.

SUSAN C. KIMMELL and E. P. DUTTON AND COMPANY, INC., a corporation,

Appellees.

APPELLEES' BRIEF.

I.

Statement of Jurisdiction.

It is submitted that the Statement of Jurisdiction appearing in appellant's opening brief is so loose and general, except as to statutory provisions, as to be inadequate. Therefore appellee submits a Statement of Jurisdiction as follows:

A. Pleadings.

1. In this action appellant seeks a declaration that a certain manuscript entitled "Gaelic" or "Old Gaelic" and a certain book entitled "The Job of Living," based upon the said manuscript and in which portions of said manuscript are quoted, are in the public domain and may be quoted without infringement of the copyright claimed

by appellee on said book or her common law proprietary rights claimed by her in said manuscript. Appellee resists on the ground that she has a statutory copyright on said book and is the owner of both said book and said manuscript and the material therein, and seeks a declaration to that effect, and an injunction restraining appellant from using or quoting from said book or said manuscript.

2. The Complaint [Tr. pp. 3-9] alleges that between the early 1920s and the early 1930s Stewart Edward White compiled or caused to be compiled a manuscript designated as "Gaelic" or "Old Gaelic"; that prior to his death in 1947 Stewart Edward White also wrote a manuscript called "The Job" or "The Job of Living" based upon the "Gaelic" manuscript and quoting portions thereof; that on October 20, 1944, Stewart Edward White transferred to appellee Susan C. Kimmell his right, title, and interest in the "Gaelic" manuscript and also in "The Job" manuscript; that in 1948 appellee Kimmell, through E. P. Dutton & Company, Inc., published said manuscript "The Job" in book form under the title "The Job of Living" and copyrighted the same in her name; that prior to 1944 Stewart Edward White abandoned the "Gaelic" manuscript to the general public by reproducing and distributing copies himself and permitting others to do the same without limitation as to use or right to republish and without notice or claim of copyright; that appellant is writing a book based upon the "Gaelic" manuscript and proposes to quote therefrom and from the copyrighted book "The Job of Living"; that appellant proposes to publish and sell his book to the general public; that a con-

troversy has arisen between appellant and appellee with respect to right of appellant to quote from the "Gaelic" manuscript and from the book "The Job of Living." The prayer is for a determination and declaration as to the rights of the parties involved in said controversy.

3. The Answer [Tr. pp. 10-15] admits the compilation of the "Gaelic" manuscript by Stewart Edward White; admits that prior to his death the said Stewart Edward White wrote a manuscript called "The Job" which is based upon the "Gaelic" manuscript and contains quotations therefrom; admits that on October 20, 1944, Stewart Edward White transferred to appellee his right, title, and interest in the "Gaelic" manuscript and in "The Job" manuscript; admits that during the year 1948 appellee, through E. P. Dutton & Company, Inc., printed, published and sold to the general public "The Job" manuscript in book form under the title "The Job of Living" and copyrighted the same; denies that prior to the year 1944, or at any other time, Stewart Edward White dedicated and abandoned the "Gaelic" manuscript to the general public by the acts alleged or otherwise; and alleges that the reproducing, lending and distribution of said manuscript by himself and others was a limited and qualified publication. The prayer is that appellant be restrained and enjoined from using or quoting from the "Gaelic" manuscript or from the book "The Job of Living."

B. Statutory Provisions for the Jurisdiction of the District Court and the United States Court of Appeals.

Statement of appellant is adopted by appellee.

II.
Statement of the Case.

It is further submitted that the Statement of the Case set forth in appellant's opening brief is lacking in clarity and conciseness. Therefore appellee submits her Statement of the Case as follows:

A. Questions Involved in This Appeal and the Manner in Which They Arise.

1. The issue raised by the pleadings is whether copies of the "Gaelic" manuscript in mimeographed form were made available by Stewart Edward White and by others, with his consent, to the general public without discrimination as to persons, or were available only to definitely selected individuals or a limited, ascertained class. On this issue hangs the validity of the copyright of appellee on the book "The Job of Living."

2. The trial court found that the reproduction and distribution of the "Gaelic" manuscript amounted to a limited and restricted publication; that there was no general publication thereof, and that said manuscript was not in the public domain.

3. It is further submitted that the specific, detailed findings, in all respects of vital importance, are amply supported by the evidence.

B. Facts.

1. The pertinent facts, stated briefly, are as follows:

a. The "Gaelic" manuscript was compiled by Stewart Edward White [Tr. pp. 62-63].

b. "The Job" manuscript was written by Stewart Edward White based on "Gaelic," and portions of "Gaelic" are quoted therein [Complaint, Par. V, p. 5 of Tr.].

c. The manuscripts of "Gaelic" and "The Job" were transferred to appellee by Stewart Edward white on October 20, 1944 [Complaint, Par. V, p. 5 of Tr.].

d. Stewart Edward White died September 18, 1946 [Tr. p. 149].

e. "The Job" manuscript was written by Stewart Edward White prior to his death [Complaint, Par. V, pp. 4-5 of Tr.], and the book "The Job of Living" was published after his death [Complaint, Par. VI, p. 5 of Tr.].

f. "The Job" manuscript was published in book form by appellee under the title "The Job of Living" and copyrighted by her in 1948 [Complaint, Par. VI, p. 5 of Tr.].

g. Stewart Edward White had copies of the "Gaelic" manuscript made by hectograph (Ditto process) [Tr. pp. 61-63] and by mimeograph [Tr. pp. 80-81].

h. Margaret Oettinger, with permission of Stewart Edward White [Defendant's Exhibit "A," Tr. p. 108], also made additional mimeographed copies of "Gaelic" [Tr. pp. 114-116].

i. Ivy Duce, with permission of Stewart Edward White made additional mimeographed copies of "Gaelic" [Tr. pp. 184-185].

j. W. N. Maguire was an employee of Stewart Edward White [Tr. p. 79].

2. With reference to the number of copies of the "Gaelic" manuscript distributed as distinguished from the number produced:

a. Appellant states that he distributed 30 to 50 [Tr. p. 77].

b. Witness Maguire states that she distributed 45 to 55 [Tr. p. 90].

c. Witness Oettinger makes no statement as to a definite number distributed, but from statement as to charges made for copies in the different "batches" mimeographed by her it might be inferred that she distributed 70 to 100 [Tr. pp. 131-133].

d. Witness Duce states that she distributed copies to Don Stevens, Mrs. Cuthbert, Mrs. Ahlstrand, Mrs. Simpson, one to Stewart Edward White and two to Mrs. Oettinger, or two to Stewart Edward White and one to Mrs. Oettinger—seven in all [Tr. p. 186].

Total number distributed (not including numbers fixed by inference) 82 to 105.

3. With reference to the persons to whom copies of the "Gaelic" manuscript were distributed:

a. By appellant: to persons selected by him [Tr. p. 77].

b. By W. N. Maguire: to list of persons selected by Stewart Edward White [Tr. pp. 82 and 84] and to four or five of her friends interested in Stewart Edward White's work [Tr. p. 86].

c. By Margaret Oettinger: to persons designated by Stewart Edward White, to two or three of her own friends [Tr. p. 109], and in compliance with requests from Stewart Edward White, Katherine Benner, and appellee [Tr. p. 128].

d. By Ivy Duce: to persons known to Stewart Edward White [Tr. p. 186].

4. With reference to copies of the "Gaelic" manuscript not being available to the general public in public libraries, etc.:

a. Appellant states that Stewart Edward White did not place a copy in public library and that no copy or copies appeared on the shelves of a retail bookseller [Tr. p. 74] and that no copy or copies were in an established commercial lending library [Tr. p. 76].

b. Witness Maguire states that no copy or copies were deposited in a public library or libraries, or on the shelves of a retail book store, or in a commercial lending library [Tr. p. 101].

c. Witness Oettinger states that she did not place a copy in a public library [Tr. p. 133].

d. Witness Jones states that no copies were available to the general public in any retail book store or public library [Tr. p. 146].

e. Appellee states that she does not know of any copy or copies in public libraries, retail book stores, or commercial lending libraries [Tr. p. 173].

f. Witness Duce states she has no knowledge of copies being in a public or rental library, and that no copies were offered for sale by anybody [Tr. p. 186].

g. Witness Stevens states that Mrs. Duce did not sell copies at retail or through retail outlets and did not place them in a lending library [Tr. p. 213].

5. With references to limitations on distributees as to use of the "Gaelic" manuscript.

a. Stewart Edward White stated in substance—I was willing that they pass copies of the manuscript around among such of their friends who want copies [Defendant's Exhibit A].

b. The appellee states: "he (Stewart Edward White) wanted it guarded very carefully and shown only to people who were particularly interested in the subject and in whose discretions—or whose discretion could be relied on, who would not copy any portions of it or produce any portions for publication [Tr. p. 159].

c. Ivy Duce states: "He (Stewart Edward White) said that it was perfectly all right for me to make a few copies, but they were to be limited and that I was only to allow a few of my close friends to see them, that I must be very careful in fact to whom I showed them, because since they had not been published anybody . . . could steal the material [Tr. pp. 184-185].

d. Don E. Stevens states: "I always made a very definite point with regard to persons to whom I lent it, that it was not to go out of their home" [Tr. p. 222].

III.
Argument.

The law has consistently distinguished between general publication and limited publication of products of the mind. The question of when there has or has not been one or the other has been before the courts many times. An early case, cited in the Opinion of the trial judge [Tr. p. 20, reference (7)], *Werkmeister v. American Lithographic Company,* 134 Fed. 321 at 326, states the general rules for distinguishing between these two kinds of publication as follows:

> "The result of an examination of the authorities seems to show that the following propositions are established: a general publication consists in such a disclosure, communication, circulation, exhibition or distribution of the subject of copyright, tendered or given, to one or more members of the general public, as implies an abandonment of the right of copyright or its dedication to the public. Prior to such publication, a person entitled to copyright may restrict the use or enjoyment of such subject to definitely selected individuals or a limited, ascertained class or he may expressly or by implication confine the enjoyment of such subject matter to some occasion or definite purpose. A publication under such circumstances is a *limited* publication and no rights inconsistent with or adverse to such restrictions are surrendered. Restrictions imposed upon the use prior to publication protect the copyright. . . . The nature of the subject matter, the character of the communication, circulation or exhibition and the nature of the rights secured are chiefly determinative of the question of publication."

In another case, also cited in the Opinion [Tr. p. 20 reference (6)], *American Tobacco Company v. Werkmeister,* 207 U. S. 284 at 299, the Supreme Court summarizes the principles above-quoted from *Werkmeister v. American Lithographic Company* as follows:

> ". . . the property of an author . . . in his intellectual creation is absolute until he voluntarily parts with the same. *One* or *many* persons may be permitted to an examination under circumstances which show no intention to part with the property right, and it will remain unimpaired." (Emphasis added.)

To constitute general publication the work must be made available in some manner and in some place to the general public without discrimination as to persons, so that any member thereof who chooses may have access thereto. There must be no restrictions of any kind imposed by the author. Whether or not the members of the general public take advantage of the opportunity thus offered is beside the point. As is said in *Jewelers Mercantile Agency v. Jewelers Weekly Publishing Company,* 49 N. E. 872 at 875 also cited in the Opinion [Tr. p. 20 reference (7)]:

> "The act of publication is the act of the author and cannot be dependent upon the act of the purchaser."

If any sort of express or implied restrictions are imposed, the result is a limited publication, and the author does not lose his property in the subject of such limited publication.

It is submitted that the effect of the production and distribution of copies of the "Gaelic" manuscript must be determined according to the foregoing principles.

A. Acts of the Author.

The attitude of Stewart Edward White with regard to publication of the "Gaelic" manuscript is most convincingly shown by the following quotation from the testimony of appellant concerning a conversation he had had with Stewart Edward White:

> "He said that he felt that Betty's work should hold the center of the stage and was more important, and he had a number of other books he wanted to get out of hers, that he had in mind. That, therefore, he didn't want to inject himself. He was always very reticent about his own work. He thought hers was more important." [Tr. p. 66.]

Since Stewart Edward White was a professional writer with established publishing connections and had already written and published a number of books dealing with the same general subject matter covered by the "Gaelic" manuscript [Tr. p. 152], there can be no mistaking what he meant when he said that he did not want to publish the "Gaelic" material in book form. Why did he not take the very obvious, convenient, and customary method of making it known to the general public? The answer is, of course, that he did not want the general public to have it.

Also, the following quotation from the testimony of Margaret Oettinger is revealing as to the author's attitude toward publication:

> "Mr. White said he had no objection to further copies being made. At that time he was not at all sure that he would ever publish it. He thought that

it was not necessary to publish it by itself. He had quoted from it in various books, and he thought it would be all right if we made some mineographed copies." [Tr. pp. 108-109.]

* * * * * * * *

"As I understand it, he said, 'I don't know if I will ever publish it.' Or something like that." [Tr. p. 117.]

Referring to Plaintiff's Exhibit "3" there is no question as to what Stewart Edward White meant when he wrote as follows to Mrs. Oettinger:

"I have no objection whatever to the distribution of copies of Gaelic, provided, of course, *it is not in published form.*" (Emphasis added.)

In the same paragraph this statement occurs: "You may go ahead at your discretion with more copies of it." The word "discretion" clearly implies that a limitation had been placed upon Mrs. Oettinger; had there been no limitation there would have been no need for discretion.

The first paragraph of Defendant's Exhibit "A" clearly shows the determination of Stewart Edward White that distribution was to be limited to ". . . such of their friends who want copies." This determination is reflected in the way in which he handled the reproduction and distribution of copies of the "Gaelic" manuscript. The testimony of Ivy Duce [Tr. pp. 186-187] and also of Don Stevens [Tr. pp. 205-206, 210, 212] and that of appellee [Tr. pp. 159-160] conclusively indicates the frame of mind of Stewart Edward White with reference to the manuscript, namely, that except for such parts as he had already quoted in "The Job" manuscript, it was not to be made available to the general public.

B. Acts of Other Parties.

Margaret Oettinger distributed copies only to persons whose names were furnished by Stewart Edward White, Katherine Benner, and appellee, and to two or three of her own friends. Ivy Duce distributed a total of seven copies to Stewart Edward White, Mrs. Oettinger, and four personal friends. It is impossible to imagine how such distribution could be construed as a publication to the general public.

Mrs. Oettinger admits that during a conference with Stewart Edward White she "made some kind of remarks about 'Of course we will just mimeograph it and distribute it at—or to friends,' or something like that. 'Give these people that want copies.' It wasn't—the whole thing was so informal that it is hard to remember even." [Tr. p. 117.] Later, she states that there was no limitation by Stewart Edward White with respect to her distribution [Tr. pp. 119, 135]. These statements are in such conflict with each other and, in part, with those of Stewart Edward White as set forth in Defendant's Exhibit "A" that one can but wonder how she could be so accurate in her memory of certain details, such as calling Stewart Edward White on the telephone, asking him if he had any objection to copies being made, and being invited by him to his home to discuss the matter [Tr. p. 121], and so vague in her recollection of the essential details of a very simple arrangement made between them. Attention is called to the fact that Defendant's Exhibit "A" is a written record made the next day after the conference at which Mrs. Oettinger received permission from Stewart Edward White to reproduce and distribute copies of the manuscript to "such of their friends who want copies," and for that reason is hardly likely to contain errors arising from a lapse of memory.

On page 15 of appellant's Opening Brief, referring to a controversy between Stewart Edward White and appellant with respect to the "Gaelic" manuscript, the statement is made that appellee "drew to herself, after the death of Stewart Edward White, the support of Mrs. Duce and Mr. Stevens in active opposition to appellant's use of the material. The testimony of this little coterie very probably is strongly colored by the controversy mentioned." This conclusion can be dismissed as idle speculation not supported by the least scintilla of evidence.

At this point it might be asked why W. N. Maguire appears so acquiescent and cooperative with respect to the efforts of appellant to circumvent the express desire of her former employer, Stewart Edward White, that neither his brother, the appellant, nor any one else should make the "Gaelic" manuscript available to the general public. It is very clear from Defendant's Exhibit "C" that Stewart Edward White did not want appellant to have anything to do with this manuscript. Is there not justification for asking the question, Is the testimony of Mrs. Maguire free from bias?

The evidence shows that mimeographed copies of the "Gaelic" manuscript were distributed to persons selected by appellant; by W. N. Maguire to a list of persons selected by Stewart Edward White and to four or five of her friends interested in Stewart Edward White's work; by Margaret Oettinger to persons designated by Stewart Edward White, to two or three of her own friends, and in compliance with requests from Stewart Edward White, Katherine Benner, and appellee; and by Ivy Duce to persons known to Stewart Edward White. In other words, the distribution was made to a list of persons directly selected by Stewart Edward White or by others acting with

his authority. Such selected persons were friends, acquaintances, or persons particularly interested in the subject matter. The evidence further shows that the manuscript was not made available to members of the general public by being placed in public libraries, commercial lending libraries, or in retail book stores.

It is suggested that the following language from *Jewelers' Mercantile Agency v. Jewelers' Weekly Publishing Company, supra,* at 875, is particularly applicable to this case:

> ". . . if a book be offered gratuitously to the general public, it will constitute publication. *This may be done by presenting it to public libraries, and this is so because the author or publisher, by that act, puts it in such a place that all the public may see it if they choose.* The reason why exposing for sale or offering gratuitously to the general public constitutes publication is stated in the last part of the rule as follows: 'So that any person may have an opportunity of enjoying that for which copyright is intended to be secured.' . . . Several cases have arisen where the courts have held that the private circulation of pictures, manuscripts, or printed books did not constitute a publication, such as Prince Albert v. Strange, *supra;* also Bartlette v. Crittenden, 4 McLean, 300 Fed. Case No. 1,082 where the plaintiff, a teacher of bookkeeping, for the convenience of his pupils, wrote his system of instructions on separate cards, which they were permitted to keep for their convenience. So a gratuitous circulation of copies of a work among friends and acquaintances has been held not to amount to a publication. Dr. Paley's Case, cited in 2 Ves. & B. 23, was one where a bookseller was restrained from publishing manuscripts left by Dr. Paley for

the use of his own parishioners only. Coppinger, in his work on Copyright, at page 117, after considering the last case cited and others, reached the following conclusion: 'The distinction is in the limit of the circulation. *If limited to friends and acquaintances, it would not be a publication; but, if general, and not so limited, it would be.*" (Emphasis added.)

C. Errors Specified Are Without Foundation.

1. In answer to specification one: The evidence shows conclusively that the "Gaelic" manuscript was distributed to a selected group, and at no time was it ever placed where any member of the general public could, if he chose, have access thereto.

2. In answer to specification two: The evidence shows that from 82 to 105 copies were distributed. This does not include copies distributed by Margaret Oettinger, the number of which can be fixed only by inference. These figures do not take into consideration the number of copies produced. It would not appear that the trial judge was far wrong in his estimate. However, the point is unimportant since the number of copies distributed has no bearing on the question of whether there was a general publication or a limited publication.

3. In answer to specification three: The evidence shows that Stewart Edward White gave Margaret Oettinger permission to "pass around copies among such of their friends who want copies," and to charge "such people the exact cost." [Defendant's Exhibit "A."] It is so clear from the authorities cited above, that distribution to "friends" is a limited Publication that the point need not be labored. There is no showing that Mrs. Oettinger acted outside of the scope of her permission. It is also

clear that she was authorized to collect from individual distributees "the exact cost" of mimeographing copies. The evidence shows that she complied with this instruction to the best of her ability [Tr. pp. 119, 131-132]. The contributions by distributees of their proportionate share of the costs have none of the earmarks of the customary vendor-vendee relationship in a commercial transaction.

4. In answer to specification four: The testimony of appellee [Tr. pp. 159-160], Ivy Duce [Tr. pp. 185-187] and Don Stevens [Tr. pp. 222-223], shows definite limitations on the use to be made of the "Gaelic" manuscript. The testimony of none of these persons has been impeached.

5. In answer to specification five: The testimony of Ivy Duce [Tr. pp. 197-198] and of Don Stevens [Tr. pp. 215-216] shows that the persons who received copies reproduced by Mrs. Duce shared the actual expenses incurred in mimeographing the manuscript. It was a cooperative enterprise only, and not a vendor-vendee transaction. There is no finding that Ivy Oneita Duce was not given permission to reproduce the "Gaelic" manuscript.

6. In answer to specification six: This specification is so loose and general as to be entirely devoid of any merit, and therefore falls of its own weight.

D. The Law.

1. The right to the product of one's intelligence, imagination, or skill, whether in the realm of literature, music, or art, was recognized by courts long before recognition was given to these rights by statute.

> 18 *Corpus Juris Secundum,* pp. 139-141, Copyright and Literary Property, Sections 4-10.

2. An author has, at common law, a right of property in his intellectual production, sometimes called the right of first publication, which still exists independent of copyright statute.

Werkmeister v. American Lithographic Company, 234 Fed. 321 at 324;

Bobbs-Merrill Company v. Straus, 147 Fed. 15 at 18 and 19;

Civil Code of California, Sections 655, 980(a), 982(a) and 983(a).

3. The copyright statute gives to an author the exclusive right to multiply copies of his work during the term fixed by the statute. When he invokes the statute he loses his rights at common law.

Jewelers' Mercantile Agency v. Jewelers' Weekly Publishing Company, 49 N. E. 872 at 873;

Bobbs-Merrill Company v. Straus, supra at 19.

4. The common law right of property which an author has in his work is lost by general publication but not by a limited or qualified publication.

Jewelers' Mercantile Agency v. Jewelers' Weekly Publishing Company, supra at 875;

Werkmeister v. American Lithographic Company, supra at 324.

5. General publication of the work of an author occurs when there is such a disclosure, communication, circulation, exhibition, or distribution tendered or given to one

or more members of the general public as implies an abandonment of the right of first publication or a dedication of the work to the public.

Jewelers' Mercantile Agency v. Jewelers' Weekly Publishing Company, supra at 875;

Werkmeister v. American Lithographic Company, supra at 324.

6. A limited publication is one made under restrictions limiting the use or enjoyment of the subject matter to definitely selected individuals or to a limited, ascertained class, or to some particular occasion or definite purpose, and no rights inconsistent with or adverse to such restrictions are surrendered.

Bartlett v. Crittenden, 2 Federal cases No. 1082;

Jewelers' Mercantile Agency v. Jewelers' Weekly Publishing Company, supra at 875;

Werkmeister v. American Lithographic Company, supra at 324;

Keene v. Wheatley, 14 Federal cases, 180 at 199, No. 7644;

Berry v. Hoffman, 189 Atl. 516 at 519.

7. Merely exhibiting a manuscript to others or making a gift of a copy thereof, or circulating copies among friends for their own personal enjoyment is not such publication as will terminate common law rights therein.

Werkmeister v. American Lithographic Company, supra at 325;

Bobbs-Merrill Company v. Straus, supra at 18.

8. The intention with which the disclosure or communication is made is a material circumstance, yet intention will be determined not by what the author says but by what he does.

Kurfiss v. Cowherd, 121 S. W. 2d 282 at 287.

In conclusion, the issues involved in this case are clear-cut and simple. A perusal of the testimony offered on behalf of appellant shows that he has failed to meet the burden of proving that there was a general publication of the "Gaelic" manuscript. In fact, the effect of all of the testimony, both on behalf of appellant and appellee, sustains the proposition that there was a limited publication thereof as defined by many well-considered authorities.

The decision should be sustained.

Respectfully submitted,

Leslie F. Kimmell,
Attorney for Appellee.